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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,172

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Rainer Uecker

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SIEMENS CORPORATION  
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170 WOOD AVENUE SOUTH  
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EXAMINER

FAN, HUA

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,172	<b>Applicant(s)</b> UECKER, RAINER	
	<b>Examiner</b> HUA FAN	<b>Art Unit</b> 2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16,21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/30/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to amendment/reconsideration filed 3/2/2009, the amendment/reconsideration has been considered. Claims 16, 21 and 23-30 are pending for examination, the rejection cited as stated below.

#### ***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The independent claims 16 and 28 recite a sequence of steps to perform the claimed invention; however, these steps are not shown in any of the figures. These features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

Art Unit: 2456

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 16, 21, and 24-30 are rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo (WO 01/20855) in view of Okada (US publication 2003/0023697).

As to claim 16, Etsuo discloses a method for transmitting messages (figure 1 and 2, "mail") in a network (figure 1 and 2, component 100) via data terminals connected thereto (figure 1 and 2, components 200A, 200B, 200C, 200D, 300), comprising:

sending a message to be relayed from a sender data terminal (figure 1 and 2, component 200A, page 24, paragraph 3, "during sending behavior, the user of client 200A...inputs information about e-mail MAILB addressed to client 200B using input unit) to a first mail processing device assigned to the sender data terminal (figure 1 and 2, component 200A; page 24, paragraph 5, "the control unit 203AS of client 200A attaches A001...as the identifier to body BOA..."; page 19, paragraph 3, "client 200A is equipped with a duplicate transmission prevention function which prevents duplicate transmission of the same e-mail"; page 10, paragraph 1, "control unit 203A...cancels sending the new e-mail if the same body included in the new e-mail is stored in the memory means");

Art Unit: 2456

assigning a unique identifier to the message) that indicates that a message to be relayed is on the sender data terminal (figure 9 and 5(a), “Identifier – A0001”, “Sender Address = A”; page 21, paragraph 2-3, “PA”, “pair of body and identifier...forwarded body and an identifier”; page 26, paragraph 6), or in the first mail processing device (page 24, paragraph 5, “the control unit 203AS of client 200A attaches A0001...as the identifier to body BOA...”; page 26, paragraph 6, “identifier (=A0001)...sender address (=A)), wherein the identifier comprises a plurality of sub-identifiers, each of which is assigned to at least one message element contained in a relayed message (page 21, paragraph 2-3, “pair of body and identifier...forwarded body and identifier”).

evaluating in the second mail processing device the identifier sent by the first mail processing device, the evaluating configured to process each sub-identifier relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1; page 20, paragraph 2, “mail server 300 has a duplicate receipt notification prevention function which avoids sending a receipt notice about forwarded email which is essentially the same as an e-mail about which the receipt notice has already been sent to the client”; page 35, paragraph 2- page 36, paragraph 4, for a forward email (originated from 200A, and forwarded by 200B, the mail server will process each sub-identifiers);

Etsuo discloses a second mail processing device assigned to a recipient address data terminal (page 10, lines 1-14, “203A-203D (client control means) cancels sending the new email if the same body included in the new e-mail is stored in the memory mean...mail server...determines, when it receives an e-mail including a body and an identifier attached tot eh body from the above-mentioned client, whether or not the said identifier matches any of the

Art Unit: 2456

identifiers relating to other e-mails received in the past, and has a control means which sends a receipt notice to the addressee of said e-mail if the result of the above-mentioned decision is a no-match and does not send a receipt notice...if...is a match" where "client control means 203A-203D of clients 200A-200D" is equivalent to the "first mail processing device"; the "control unit 301" of the "mail server" is equivalent to the "second mail processing device" assigned to "a recipient address data terminal" (the addresses of said e-mail that the control unit 301 of the mail server determines to send or not to send the receipt notice to); the second mail processing device (mail server)'s evaluation result indicates transmitting the message elements, evaluated as not previously relayed to the recipient address data terminal; and blocking message elements evaluated as previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1); the first mail processing device (client control means)'s evaluation result to transmitting or blocking a transmission of respective ones of the message elements to the second mailing processing device in response to the client's evaluation result (abstract; page 9, paragraph 4 – page 10, paragraph 1); and relaying to the recipient address data terminal respective message elements transmitted from the first mail processing device to the second mail processing device (page 10, paragraph 1, "sends a receipt notice to the addressee"; page 7, paragraph 3, client accesses to mail server upon receiving the notice), and where in said transmitting or blocking of respective ones of the message elements is configured to suppress a duplicative reception by the recipient address data terminal of a message element present in a message previously received by the recipient address, and is further configured to ensure that an amended message element of a message element present in the previously received message is transmitted to the recipient address (page 20, paragraph 2, "mail server 300 has a duplicate

Art Unit: 2456

receipt notification prevention function which avoids sending a receipt notice about forwarded email which is essentially the same as an e-mail about which the receipt notice has already been sent to the client”; page 35, paragraph 2- page 36, paragraph 4, for a forward email (originated from 200A, and forwarded by 200B, the mail server will process each sub-identifiers. It is to be noted that the "amended message elements" is interpreted as a new/different message, therefore is not blocked by the above cited teachings. The interpretation is consistent with specification PGPub paragraph [0032]).

However, Etsuo does not expressly disclose sending a test message from the first mail processing device to the second mail processing device; sending an evaluation-result of the test message from the second mail processing device to the first mail processing device, first mail processing device transmitting or blocking message in response to the evaluation-result message; wherein said transmitting or blocking of respective ones of the message elements in response to the evaluation-result of the test message. Okada discloses sending a test message from the first mail processing device to the second mail processing device ([0010], “a first communication device...adds only the title of the attachment file and then transmits the electronic mail); sending an evaluation-result of the test message from the second mail processing device to the first mail processing device ([0010], “second communication device can be constructed to demand the transmission of the content of the attachment file”; [0043], “the electronic mail handling unit 22 demands the transmission of the content of the attachment file indicated by the user, to the communication device 1 which is the transmitter of the electronic mail”), first mail processing device transmitting or blocking message in response to the evaluation-result message ([0044], “the communication device 1 which received the transmission demand of the content of the

Art Unit: 2456

attachment file from the communication device 2, transmits to the communication terminal device 2, the content of the attachment file which is demanded to be transmitted"); wherein said transmitting or blocking of respective ones of the message elements in response to the evaluation-result of the test message ([0010], "when the first communication device receives the transmission demand for the content of the attachment file from the second communication device, the first communication device forwards the content of the attachment file to the second communication device"; [0044], "a new electronic mail attached with the content of the attachment file is generated by the electronic mail generating unit 13, and the electronic mail is transmitted to the communication device 2 from the communication unit 14").

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the teachings disclosed by Etsuo with the teachings disclosed by Okada regarding sending a test message from the first mail processing device to the second mail processing device; sending an evaluation-result of the test message from the second mail processing device to the first mail processing device, first mail processing device transmitting or blocking message in response to the evaluation-result message; wherein said transmitting or blocking of respective ones of the message elements in response to the evaluation-result of the test message. The suggestion/motivation of the combination would have been to save communication expenses and memory capacity (Okada, [0048]).

As to claim 21, Etsuo-Okada discloses the method according to claim 17, wherein the identifier is evaluated on a mail server in the network (Etsuo, page 10, paragraph 1; figure 1).

As to claim 24, Etsuo-Okada discloses the method according to claim 17, wherein the identifier and/or the relevant sub-identifier indicates an e-mail address of an original sender if



Art Unit: 2456

this differs from the e-mail address of the sender, and/or the contents of the message or of the respective message element (Etsuo, page 33, paragraph 4-5, “A0001” where “A” indicates address of original e-mail sender, “BOA” indicates body of original sender; “B0001” where B indicates address of the forwarding email sender, “BOB” indicates the forwarding body. Also see figure 5, “Sender address = A”, original sender).

As to claim 25, Etsuo-Okada discloses the method according to claim 16, wherein there is a data terminal for executing the method (Etsuo, claims 1-2 and 7; page 10, paragraph 1, control units 203A-203D of clients 200A-200D) and having a mail processing device that is designed such that an identifier for a message based on data present concerning the entry of messages at an address data terminal from the past is evaluated in an evaluation unit (Etsuo, claims 1-2 and 7; page 10, paragraph 1, “control unit 301” of mail server), and such that, based on the evaluation result, transmission of a message to the address data terminal is triggered or blocked (Etsuo, claims 1-2 and 7; page 10, paragraph 1).

As to claim 26, Etsuo-Okada discloses the method according to claim 25, wherein the mail-processing device forms part of a mail server (Etsuo, claim 1; page 10, paragraph 1, “control unit 301”, the mail processing device, is part of the mail server), which is integrated in the data terminal (Etsuo, mail server can be used as data terminal as well since it is able to generating and receiving emails, page 22, paragraph 4; also see page 42, paragraph 3, the method can be implemented on an integrated single computer).

As to claim 27, Etsuo-Okada discloses the method according to claim 25, wherein a memory unit for storing data concerning the entry of messages at a different data terminal (Etsuo, mail server 300, page 22, paragraph 4 – page 23, paragraph 1; page 10, paragraph 1, each

Art Unit: 2456

client's control unit (for example 200A) has the data stored in its own memory unit (205A in this case)).

Claim 28 is a network claim corresponding to the method claim 1. Therefore it has been analyzed and rejected based upon the method claim.

As to claim 29, see similar rejection to claim 26.

As to claim 30, Etsuo-Okada discloses the network according to claim 29, further comprising a memory unit for storing previously relayed message elements (Etsuo, page 35, paragraph 4, "control unit 301 holds forwarding body BO of forwarding e-mail MAILab in the memory unit 303"; page 10, paragraph 1, "if the same body included in the new e-mail is stored in the above-mentioned memory means...whether or not the said identifier matches any of the identifiers relating to the e-mails received in the past").

6. Claim 23 is rejected under 35 U.S.C. 103(a) as unpatentable over Etsuo, in view of Okada, as applied to claim 16 above, and further in view of Yoshihiro (JP 11232188).

As to claim 23, Etsuo-Okada does not expressly disclose a notification of the blocked transmission is forwarded to the sender and/or recipient if the transmission is blocked on the basis of the evaluation result. Yoshihiro discloses a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email (abstract).

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to combine the method disclosed by Etsuo-Okada with the method disclosed by Yoshihiro regarding a duplicate notice mail is transmitted to the originator of the received electronic mail when it blocks the transmission of the email. The suggestion/motivation of the combination

Art Unit: 2456

would have been to inform the originator that the predetermined title and predetermined message of the received E-mail are the same (Yoshihiro, [0020]).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUA FAN whose telephone number is (571)270-5311. The examiner can normally be reached on M-F 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2456

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. F./

Examiner, Art Unit 2456

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2456